Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed breathable film can be made by another materially different process such as casting followed by drawing rather than extruding followed by drawing.

Applicants submit that the Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group II were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Overall, Applicants elect the claims of Group II with traverse. This Office Action response serves to affirm the election of the claims of Group II, which are claims 13-17 and 25-33.

§112 Rejection

Claim 32 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action provides that the limitation of "an A layer" in line 2 of Claim 32 has insufficient antecedent basis.

Applicants amend Claim 32 as provided above. Claim 32 should depend from Claim 29 rather than from Claim 25. *See* Specification, page 8, lines 11-21. Therefore,

Claim 32 has been amended accordingly. Furthermore, the §112 rejection as to Claim 32 should be withdrawn.

§102(b) Rejection

Claim 13 stands rejected under 35 U.S.C. §102(b) as being anticipated by Tenneco Chemicals Inc. (GB 1321489).

The rejection of Claim 13 under §102(b) should be withdrawn. Tenneco uses thermoset polymers to form its foam. In the present application, thermoplastic polymers are used. (Definitions of "thermoset" and "thermoplastic" are provided on p. 113 of Principles of Polymerization, 2nd ed., John Wiley & Sons, 1981, which is attached to this Response). Claim 13 has been amended to add "thermoplastic" to the description of the amorphous polymer in order to more clearly distinguish the present invention from Tenneco. Support for this amendment can be found in original Claim 25, and on page 11, lines 22 of the Specification.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Because the Tenneco reference does not describe every element in Claim 13 as amended, Applicants respectfully submit that Tenneco does not support a §102(b) rejection of the claimed invention and request that the rejection of Claim 13 be withdrawn.

§102(b)/§103(a) Rejection

Claims 13-17, 25-31 and 33 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over McCormack (WO 95/16562).

First, in support of the §102(b) rejection, the Office Action provides that the film in McCormack (WO 95/16562) is comprised of an "amorphous thermoplastic elastomer polymer" because the reference includes mention of a "linear low density polyethylene." Second, the Office Action goes on to describe the microvoiding process used in the method to form the film in the reference. Third, the Office Action provides that the reference

discloses a three layer composite that reads on the ABA structure in the present application. Fourth, the Office Action provides that the reference discloses an absorbent layer adjacent a web layer, which reads on at least one A layer of the present application's ABA structure.

In support of the §103(a) rejection with respect to the same claims, the Office Action provides that the reference "does not specifically disclose a breathable film having at least one major surface, having porosity in the direction perpendicular to that major surface, and having at least one ruptured cell." However, the Office Action provides that "any film layer inherently have at least one major surface," and that "[i]t would have been obvious to one of ordinary skill in the art to have stretched the elastomeric film to rupture the cells, thus creating pores perpendicular to the major surface, in order to increase the porosity of the film resulting in the desired and disclosed water vapor transmission rate."

The rejection of Claims 13-17 and 25-31 under §102(b) and 103(a) should be withdrawn. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). According to MPEP 2142, to establish a case of *prima facie* obviousness, the prior art reference(s) must teach or suggest all the claim limitations.

First, McCormack (WO 95/16562) uses semi-crystalline polymers. Semi-crystalline polymers are a different class of polymers than amorphous ones, which are used in the present application. (Definitions of "amorphous polymers" and "semi-crystalline polymers" are provided on p. 35 of Principles of Polymer Processing, by Zehev Tadmor et al., John Wiley & Sons, 1979, which is attached). Although the Office Action asserts that the "linear low density polyethylene" mentioned in the reference is amorphous, it is not. It is semi-crystalline. (See Principles of Polymerization, by George Odian, Second Ed., John Wiley & Sons, 1981, p. 290, which is attached). Therefore, since an element of the claimed invention is missing from the cited reference, the §102(b) rejection of Claims 13-17 and 25-31 should be withdrawn.

Second, the McCormack (WO 95/16562) reference does not teach or suggest all the claim limitations. The McCormack film is not a "foam." A foam consists of a minimum of two phases, a solid polymer matrix and voids formed by a gaseous phase derived from a blowing agent. (See generally, page 1 of Handbook of Polymeric Foams

and Foams Technology, Daniel Kempner et al., editors, 1991, which is attached). The present inventive process includes a foam which is produced by a foaming process. A blowing agent creates the voids, which are stretched to further create more porosity. The film of the reference, however, is produced by a microvoiding process in which pieces of calcium carbonate are used to create voids in the film. No blowing agent is used, and no foaming takes place. Therefore, the McCormack reference does not disclose a foam and does not render the claims of the present application obvious, and the rejection should be withdrawn.

§102(e)/§103(a) Rejection

Claims 13-17, 25-31 and 33 are rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over McCormack et al. (USPN 6,111,163) ('163 patent).

The Office Action provides that the '163 patent composite reads on at least one A layer of the three-layer ABA structure of the present application. In addition, the Office Action provides that the '163 patent "does not specifically disclose a breathable film having at least one major surface, having porosity in the direction perpendicular to that major surface, and having at least one ruptured cell." However, the Office Action provides that "any film layer inherently have at least one major surface," and that "[i]t would have been obvious to one of ordinary skill in the art to have stretched the elastomeric film to rupture the cells, thus creating pores perpendicular to the major surface, in order to increase the porosity of the film resulting in the desired and disclosed water vapor transmission rate."

The rejection of Claims 13-17, 25-31 and 33 under §102(e) and 103(a) should be withdrawn. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). According to MPEP 2142, to establish a case of *prima facie* obviousness, the prior art reference(s) must teach or suggest all the claim limitations.

First, McCormack ('163 patent) uses semi-crystalline polymers. Semi-crystalline polymers are a different class of polymers than amorphous ones, which are used in the

present application. (Definitions of "amorphous polymers" and "semi-crystalline polymers" are provided on p. 35 of Principles of Polymer Processing, by Zehev Tadmor et al., John Wiley & Sons, 1979, which is attached). Although the Office Action asserts that the "linear low density polyethylene" mentioned in the reference is amorphous, it is not. It is semi-crystalline. (See Principles of Polymerization, by George Odian, Second Ed., John Wiley & Sons, 1981, p. 290, which is attached). Therefore, since an element of the claimed invention is missing from the cited reference, the §102(e) rejection of Claims 13-17, 25-31 and 33 should be withdrawn.

Second, the McCormack ('163 patent) reference does not teach or suggest all the claim limitations. The McCormack film is not a "foam." A foam consists of a minimum of two phases, a solid polymer matrix and voids formed by a gaseous phase derived from a blowing agent. (See generally, page 1 of Handbook of Polymeric Foams and Foams Technology, Daniel Kempner et al., editors, 1991, which is attached). The present inventive process includes a foam which is produced by a foaming process. A blowing agent creates the voids, which is stretched to further create more porosity. The film of the reference, however, is produced by a microvoiding process in which pieces of calcium carbonate are used to create voids in the film. No blowing agent is used, and no foaming takes place. Therefore, the McCormack reference does not disclose a foam and does not render the claims of the present application obvious, and the rejection should be withdrawn.

§103(a) Rejection

Claim 32 is rejected under §103(a) as being unpatentable over McCormack (WO 95/16562 and USPN 6111163) as applied to claim 25 above, and further in view of Bierenbaum (USPN 3426754).

According to MPEP 2142, to establish a case of *prima facie* obviousness, there must be some suggestion or motivation, either in the references or generally known to one of skill in the art, to modify or combine reference teachings, there must be some reasonable expectation of success, and the prior art reference(s) must teach or suggest all the claim limitations.

As discussed in the sections above, the McCormack patents (both of them) use semi-crystalline polymers and not amorphous ones. Second, the films of the two references are not foams. Bierenbaum also does not a foam, but teaches drawing a film. Also, it does not include amorphous thermoplastic polymers. Therefore, the combination of the references does not teach or suggest all of the claim limitations. In addition, there is no suggestion or motivation to combine the references in any way. Accordingly, the §103(a) rejection with response to Claim 32 should be withdrawn.

Amendments to Claims 25 and 29

Support for the amendments, above, to claims 25 and 29 appear in the Specification at page 14, lines 15-32, page, and in the original claims 25 and 29.

Based on the foregoing, it is submitted that the application is in condition for allowance. Reconsideration of the rejections is requested. Allowance of Claims 13-17, 25-33 is also requested. Also, amendment of the claims, as provided above, is requested.

The Examiner is invited to contact Applicants' attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

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Version With Markings to Show Changes Made

13. (Amended) An article comprising a breathable foam layer, the layer comprising [an] a thermoplastic, amorphous polymer, the foam layer further having at least one major surface and having porosity in a direction perpendicular to a major surface.

25. (Amended) An article comprising at least two layers wherein at least one layer comprises a breathable, amorphous, thermoplastic foam having at least one major surface and having at least one ruptured cell, and wherein the foam layer has porosity in a direction perpendicular to a major surface of the foam and wherein a second layer comprises a polymeric material.

29. (Amended) An [The] article [of claim 25] comprising a breathable three layer ABA structure, wherein the B layer is a breathable, thermoplastic [amorphous] foam having at least one major surface and having at least one ruptured cell and wherein the B layer has porosity in a direction perpendicular to a major surface of the foam, and wherein the A layers comprise an unfoamed material.

32. (Amended) The article of claim [25] 29 further comprising a pressure sensitive adhesive layer affixed to a major surface of [an] at least one A layer.